

PTO Form 1857 (Rev 9/05)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78587872
LAW OFFICE ASSIGNED	LAW OFFICE 116
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examining Attorney has made Final the refusal to grant registration on the grounds of a likelihood of confusion of the mark with a prior registered mark in the Official Action of June 30, 2006. Applicant respectfully requests that the Examining Attorney reconsider and withdraw this refusal for the following reasons:</p> <p>I. No Likelihood of Confusion Between Applicant's Mark and U.S. Reg. No. 2,926,406.</p> <p>In making the argument for the rejection as to confusing similarity, the Examiner points to only a portion of the mark, specifically the term "UTOPIA". However, Applicant's mark is "GREEN UTOPIA" and the cited registrant's mark is "UTOPIA", as such the mark must be reviewed for likelihood of confusion as a whole and should not be broken into component parts to reach a conclusion of confusing similarity. <i>In re Hearst Corp.</i>, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) ("marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight." . . . "When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely."). It is well established that there is nothing improper, under certain circumstances, to give more or less weight to a particular portion of a mark. See <i>In re National Data Corp.</i>, 753 F.2d 1056, 224 USPQ 749 (Fed.Cir. 1985). The cited registrant's mark is a word mark consisting of the term "UTOPIA". Applicant's mark is for the word mark "GREEN UTOPIA". The addition of the term "GREEN" makes the marks different in appearance. In terms of connotation, the marks are quite different as well. The cited registrant's mark "UTOPIA", taken literally, would mean "perfect harmony" as opposed to, presumably, imperfect harmony. In the Applicant's mark, the word "GREEN" modifies the word "UTOPIA", giving Applicant's and the cited registrant's marks completely different meanings. More importantly, the presence of the word "GREEN" as the dominant feature in the Applicant's mark gives Applicant's mark a meaning which simply does not exist in the cited registrant's mark. The term "Green" in relation to nutritional products has the connotation of the leafy "green" vegetables like lettuce, spinach and kale. As such, the connotation of the Applicant's mark would be that of green vegetables creating harmony in the body. Since this connotation is markedly different from the cited registration, there is no likelihood of confusion between the marks. Accordingly, the marks are not similar in appearance, connotation, or sound. Even if the Examiner focuses on the general impression retained by the purchasing consumer, the Applicant feels that the above arguments show that the marks are not similar enough for a finding of a likelihood of</p>	

confusion.

In the Final Official Action, the Examiner has incorrectly correlated the breaking apart of marks into their component parts with giving more or less weight to a particular portion of a mark. *See Final Official Action at Page 2*. Clearly, these two doctrines are not related in form or function. The Applicant stated in the earlier response to the Official Action that the Examiner has broken apart the applicants mark into its elements to find the likelihood of confusion basis. The Examiner replied in the Final Official Action that she need not break apart the mark into its component parts because the term "UTOPIA" is the dominant feature of the mark. The Examiner has not provided any analysis whatsoever as to why the term "UTOPIA" should garner more weight in the Applicant's mark. The Examiner makes short shrift of the argument by making the unsupported statement that the term "UTOPIA" is an arbitrary term. This is simply incorrect. The laudatory term "Utopia" is clearly one of the most un-arbitrary terms in the English language on par with "Eden" and "Heaven". Therefore, the Examiner's argument that the consumers are far more likely to emphasize the term "UTOPIA" and not "GREEN" in the Applicant's mark falters. This only leaves the dissection of the Applicant's mark for the Examiner to find confusion between the parties' marks. Therefore, the Applicant's earlier argument that the Examiner has improperly dissected the Applicant's mark is well founded.

The Applicant argues that in a recent citable case, the Board has examined similar marks as in the instant proceeding in that the marks were "GENUINE SKIN" and "GENUINE RIDE SKIN CARE" for use on skin care products. *Truescents LLC v. Ride Skin Care, L.L.C.*, Opposition No. 91158556 (TTAB November 14, 2006). The Board found no likelihood of confusion because of the lack of similarity in commercial impression of the relevant marks because the term "GENUINE" was not the dominant portion of the applicant's mark, finding instead that the term "RIDE" was arbitrary as applied to the goods of the applicant, and therefore the dominant feature. In the present case, the dominant portion of the Applicant's mark is "GREEN" not "UTOPIA" as argued by the Examiner. The distinctive term in the Applicant's mark is "GREEN" and is most likely to be viewed and used by purchasers as the primary source indicating feature in Applicant's mark. Therefore, since the dominant feature of the Applicant's mark is "GREEN" and the cited registration consists solely of the term "UTOPIA", there can be no likelihood of confusion between these marks. Comparing the marks in their entireties, Applicant argues that any similarity between the marks which results from the presence of that laudatory and weak word in both marks is greatly outweighed by the obvious dissimilarities between the marks, most importantly the presence of the arbitrary word "GREEN" in Applicant's mark and the absence of that word from the cited registrant's mark. Purchasers will readily look to the "GREEN" portion of Applicant's mark as a means of distinguishing between the sources of Applicant's and the cited registrant's products. They are not likely to assume the existence of a source connection merely because of the presence of the laudatory word "UTOPIA" in both marks. *Cf. Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005)(NORTON-MCNAUGHTON ESSENTIALS not confusingly similar to ESSENTIALS).

Regarding the Examiner's statement that the Applicant's argument "seems to suggest" it would be acceptable for a third-party to register a mark such as "Orange Coke" despite the existence of the registered mark "Coke" because the two look differently in a side-by-side comparison. Applicant respectfully disagrees. Suspending various trademark likelihood of confusion principals such as dilution, distinctiveness, and many others, Applicant simply made the side-by-side argument to illustrate that there is no likelihood of confusion between the marks since the cited registration consists of the non-distinctive term "UTOPIA" and the Applicant's composite mark uses the coined term "GREEN UTOPIA". The overall consumer impression is different to such a degree that confusion as to the source of the goods offered under the respective marks is not likely to result. In the present case, a large portion, if not all, of any potential exposure that consumers would have with the

parties' marks would be in a side-by-side situation such as in a retail store. Applicant believes that the format in which the consumer will encounter the parties' marks is important to the comparison process.

The Examiner further makes the accusatory statement that "clearly, the applicant has done nothing more than add the term 'GREEN' to the registered mark 'UTOPIA'". See *Final Official Action at Page 3*. This is of course unsupported by any evidence whatsoever. The Applicant is one the largest manufacturers of nutritional supplements in the United States and maintains a sterling reputation throughout the country as a respected company. The Applicant coined the term "GREEN UTOPIA" without any prior knowledge of the cited registrant's mark.

As argued earlier, the common term between the Applicant's mark and the cited registration which formed the basis of the Examiners refusal is the term "UTOPIA". The term "UTOPIA" in relation to trademarks has a varied and widespread use. The TTAB has given weight to credible and probative evidence of widespread, significant, and unrestrained use by third parties of marks containing elements in common to demonstrate that confusion is not, in fact, likely. *Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.*, 1 U.S.P.Q.2d 1445, 1462 (TTAB 1986). Applicant contends that the mark "UTOPIA" is a weak mark which is used to describe numerous goods and services outside of the scope of the Registrant's goods. A simple search of the *TESS* list of registrations and applications containing the term "UTOPIA" returned over 192 instances and is probative to demonstrate that the term "UTOPIA", in various forms and permutations, has been adopted by a number of other users as a good or service designation and is not distinctive of the cited registrant. In the case of weak marks, even slight differences between the marks may be deemed sufficient to avoid a finding that confusion is likely. See *In re Dayco Products -Eaglemotive Inc.*, 9 U.S.P.Q.2d 1910, 1912 (TTAB 1988) ("As such, we find the term to be a relatively weak mark and we agree with applicant that the scope of protection afforded such a mark is considerably narrower than that afforded a more arbitrary designation."); see also *In re Copytele Inc.*, 31 U.S.P.Q.2d 1540, 1542 (TTAB 1994). Evidence of widespread third-party use in a particular field of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field. *In re Broadway Chicken Inc.*, 38 U.S.P.Q.2d 1559, 1565 -1566 (TTAB 1996). Here, consumers are accustomed to seeing the term "UTOPIA" used in conjunction with various trademarks. The consumer would look to the other terms in the marks for identification of the source of the goods, which as discussed earlier, makes the marks dissimilar.

In the Final Office Action, the Examiner has rejected Applicant's above argument as to the non-distinctiveness of the term "UTOPIA". The Examiner has provided no evidentiary support for the statement that the term "UTOPIA" is not a weak mark. Additionally, the Examiner's argument that only three applications/registrations in Class 5 makes the mark "UTOPIA" distinctive is flawed because of various arguments that the Examiner is familiar with such as lack of inherent distinctiveness, zone of expansion, similarity of trade channels, and many others that the Examiner did not address. Applicant argues that the level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely. *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978). That is, the descriptiveness of a mark may result in a more narrow scope of protection. As the Court stated in *Sure-Fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158, 117 USPQ 295, 297, in which no likelihood of confusion was found between SURE-FIT and RITE-FIT for ready-made slip covers:

- It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong

trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. *Id.*

Third-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) ("Said third party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection. Used in this limited manner, 'third party registrations are similar to dictionaries showing how language is generally used.'") (Internal citation omitted.) "Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services." *Institut National Des Appellations D'Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (third-party registrations found to be "persuasive evidence"). Here, the presence of the term "UTOPIA" in over 192 existing applications and registrations is evidence that the mark is not coined, arbitrary or distinctive. The Examiner's narrowing of the third-party registrations down to "live" applications or registrations is without any support whatsoever and appears to be pure opinion on the part of the Examiner. Similarly, the Examiner's analysis regarding the uses of the mark limited to Class 5 is without support as well. The mark "UTOPIA" was first registered in 1915 for "canned and dried fruits" and various other food products, U.S. Reg. No. 0102593. Does the fact that this registration is now expired change the fact that it was registered in 1915 on goods that arguably are in the same channels of trade of the cited registrant's goods? The Applicant believes it does not. It does show that the cited registrant did not coin the term "UTOPIA" for use on nutritional or dietary goods. Additionally, the mark "UTOPIA" is the subject of a "live" application for use on "bottled water," U.S. Reg. No. 1468587, again, arguably within the same channels of trade of the cited registrant's goods. This mark was registered in 1987, prior to the present cited registrant's application for registration. The Applicant argues that the Examiner's limitation to "live" applications and registrations and International Class 5 is improper and does not allow for a proper examination of the prior third-party marks.

Although the cited registrant's mark "UTOPIA" is contained within Applicant's mark "GREEN UTOPIA", because "Utopia" is such a highly suggestive and commonly used term, consumers are not likely to believe that the marks identify a single source for the goods simply because they both contain this term. Applicant believes that the additional wording in its mark is sufficient to distinguish the mark from the cited registrant's mark. As such, the term "UTOPIA" is a very dilute mark to such a degree that the public is inundated with this term in day to day life on an assortment of goods and services, and therefore it should be granted very narrow trademark protection on this basis. In the present case, consumers will not be confused as to the source of the goods in question due to the arbitrary nature of the Applicant's "GREEN UTOPIA" mark and the registrant's nondistinctive mark "UTOPIA". As can be seen from the above arguments, there is no likelihood of confusion.

II. CONCLUSION.

Based on the foregoing analysis, Applicant requests that the Examiner reconsider the final rejection of this application and that the present application be passed to publication at an early date. Applicant has simultaneously filed a Notice of Appeal with the Trademark Trial and Appeal Board concerning this application for registration.

SIGNATURE SECTION

DECLARATION SIGNATURE

/1303-30/

SIGNATORY'S NAME	John S. Egbert
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	01/01/2007
RESPONSE SIGNATURE	/1303-30/
SIGNATORY'S NAME	John S. Egbert
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	01/01/2007
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Jan 01 23:41:46 EST 2007
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PTO Form 1957 (Rev 9/05)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **78587872** has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

The Examining Attorney has made Final the refusal to grant registration on the grounds of a likelihood of confusion of the mark with a prior registered mark in the Official Action of June 30, 2006. Applicant respectfully requests that the Examining Attorney reconsider and withdraw this refusal for the following reasons:

I. No Likelihood of Confusion Between Applicant's Mark and U.S. Reg. No. 2,926,406.

In making the argument for the rejection as to confusing similarity, the Examiner points to only a portion of the mark, specifically the term "UTOPIA". However, Applicant's mark is "GREEN UTOPIA" and the cited registrant's mark is "UTOPIA", as such the mark must be reviewed for likelihood of confusion as a whole and should not be broken into component parts to reach a conclusion of confusing similarity. *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) ("marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." . . . "When GIRL is

given fair weight, along with VARGA, confusion with VARGAS becomes less likely.). It is well established that there is nothing improper, under certain circumstances, to give more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed.Cir. 1985). The cited registrant's mark is a word mark consisting of the term "UTOPIA". Applicant's mark is for the word mark "GREEN UTOPIA". The addition of the term "GREEN" makes the marks different in appearance. In terms of connotation, the marks are quite different as well. The cited registrant's mark "UTOPIA", taken literally, would mean "perfect harmony" as opposed to, presumably, imperfect harmony. In the Applicant's mark, the word "GREEN" modifies the word "UTOPIA", giving Applicant's and the cited registrant's marks completely different meanings. More importantly, the presence of the word "GREEN" as the dominant feature in the Applicant's mark gives Applicant's mark a meaning which simply does not exist in the cited registrant's mark. The term "Green" in relation to nutritional products has the connotation of the leafy "green" vegetables like lettuce, spinach and kale. As such, the connotation of the Applicant's mark would be that of green vegetables creating harmony in the body. Since this connotation is markedly different from the cited registration, there is no likelihood of confusion between the marks. Accordingly, the marks are not similar in appearance, connotation, or sound. Even if the Examiner focuses on the general impression retained by the purchasing consumer, the Applicant feels that the above arguments show that the marks are not similar enough for a finding of a likelihood of confusion.

In the Final Official Action, the Examiner has incorrectly correlated the breaking apart of marks into their component parts with giving more or less weight to a particular portion of a mark. See *Final Official Action at Page 2*. Clearly, these two doctrines are not related in form or function. The Applicant stated in the earlier response to the Official Action that the Examiner has broken apart the applicants mark into its elements to find the likelihood of confusion basis. The Examiner replied in the Final Official Action that she need not break apart the mark into its component parts because the term "UTOPIA" is the dominant feature of the mark. The Examiner has not provided any analysis whatsoever as to why the term "UTOPIA" should garner more weight in the Applicant's mark. The Examiner makes short shrift of the argument by making the unsupported statement that the term "UTOPIA" is an arbitrary term. This is simply incorrect. The laudatory term "Utopia" is clearly one of the most un-arbitrary terms in the English language on par with "Eden" and "Heaven". Therefore, the Examiner's argument that the consumers are far more likely to emphasize the term "UTOPIA" and not "GREEN" in the Applicant's mark falters. This only leaves the dissection of the Applicant's mark for the Examiner to find confusion between the parties' marks. Therefore, the Applicant's earlier argument that the Examiner has improperly dissected the Applicant's mark is well founded.

The Applicant argues that in a recent citable case, the Board has examined similar marks as in the instant proceeding in that the marks were "GENUINE SKIN" and "GENUINE RIDE SKIN CARE" for use on skin care products. *Truescents LLC v. Ride Skin Care, L.L.C.*, Opposition No. 91158556 (TTAB November 14, 2006). The Board found no likelihood of confusion because of the lack of similarity in commercial impression of the relevant marks because the term "GENUINE" was not the dominant portion of the applicant's mark, finding instead that the term "RIDE" was arbitrary as applied to the goods of the applicant, and therefore the dominant feature. In the present case, the dominant portion of the Applicant's mark is "GREEN" not "UTOPIA" as argued by the Examiner. The distinctive term in the Applicant's mark is "GREEN" and is most likely to be viewed and used by purchasers as the primary source indicating feature in Applicant's mark. Therefore, since the dominant feature of the Applicant's mark is "GREEN" and the cited registration consists solely of the term "UTOPIA", there can be no likelihood of confusion between these marks. Comparing the marks in their entireties, Applicant argues that any similarity between the marks which results from the presence of that laudatory and weak word in both marks is greatly outweighed by the obvious dissimilarities between the marks, most importantly the presence of the arbitrary word "GREEN" in Applicant's mark and the absence of that word from the cited registrant's mark. Purchasers will readily look to the "GREEN" portion of Applicant's mark as a

means of distinguishing between the sources of Applicant's and the cited registrant's products. They are not likely to assume the existence of a source connection merely because of the presence of the laudatory word "UTOPIA" in both marks. *Cf. Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005)(NORTON-MCNAUGHTON ESSENTIALS not confusingly similar to ESSENTIALS).

Regarding the Examiner's statement that the Applicant's argument "seems to suggest" it would be acceptable for a third-party to register a mark such as "Orange Coke" despite the existence of the registered mark "Coke" because the two look differently in a side-by-side comparison. Applicant respectfully disagrees. Suspending various trademark likelihood of confusion principals such as dilution, distinctiveness, and many others, Applicant simply made the side-by-side argument to illustrate that there is no likelihood of confusion between the marks since the cited registration consists of the non-distinctive term "UTOPIA" and the Applicant's composite mark uses the coined term "GREEN UTOPIA". The overall consumer impression is different to such a degree that confusion as to the source of the goods offered under the respective marks is not likely to result. In the present case, a large portion, if not all, of any potential exposure that consumers would have with the parties' marks would be in a side-by-side situation such as in a retail store. Applicant believes that the format in which the consumer will encounter the parties' marks is important to the comparison process.

The Examiner further makes the accusatory statement that "clearly, the applicant has done nothing more than add the term 'GREEN' to the registered mark 'UTOPIA'". *See Final Official Action at Page 3*. This is of course unsupported by any evidence whatsoever. The Applicant is one the largest manufactures of nutritional supplements in the United States and maintains a sterling reputation throughout the country as a respected company. The Applicant coined the term "GREEN UTOPIA" without any prior knowledge of the cited registrant's mark.

As argued earlier, the common term between the Applicant's mark and the cited registration which formed the basis of the Examiners refusal is the term "UTOPIA". The term "UTOPIA" in relation to trademarks has a varied and widespread use. The TTAB has given weight to credible and probative evidence of widespread, significant, and unrestrained use by third parties of marks containing elements in common to demonstrate that confusion is not, in fact, likely. *Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.*, 1 U.S.P.Q.2d 1445, 1462 (TTAB 1986). Applicant contends that the mark "UTOPIA" is a weak mark which is used to describe numerous goods and services outside of the scope of the Registrant's goods. A simple search of the TESS list of registrations and applications containing the term "UTOPIA" returned over 192 instances and is probative to demonstrate that the term "UTOPIA", in various forms and permutations, has been adopted by a number of other users as a good or service designation and is not distinctive of the cited registrant. In the case of weak marks, even slight differences between the marks may be deemed sufficient to avoid a finding that confusion is likely. *See In re Dayco Products -Eagle motive Inc.*, 9 U.S.P.Q.2d 1910, 1912 (TTAB 1988) ("As such, we find the term to be a relatively weak mark and we agree with applicant that the scope of protection afforded such a mark is considerably narrower than that afforded a more arbitrary designation."); *see also In re Copytele Inc.*, 31 U.S.P.Q.2d 1540, 1542 (TTAB 1994). Evidence of widespread third-party use in a particular field of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field. *In re Broadway Chicken Inc.*, 38 U.S.P.Q.2d 1559, 1565-1566 (TTAB 1996). Here, consumers are accustomed to seeing the term "UTOPIA" used in conjunction with various trademarks. The consumer would look to the other terms in the marks for identification of the source of the goods, which as discussed earlier, makes the marks dissimilar.

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statement that the term "UTOPIA" is not a weak mark. Additionally, the Examiner's argument that only three applications/registrations in Class 5 makes the mark "UTOPIA" distinctive is flawed because of various arguments that the Examiner is familiar with such as lack of inherent distinctiveness, zone of expansion, similarity of trade channels, and many others that the Examiner did not address. Applicant argues that the level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely. *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978). That is, the descriptiveness of a mark may result in a more narrow scope of protection. As the Court stated in *Sure-Fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158, 117 USPQ 295, 297, in which no likelihood of confusion was found between SURE-FIT and RITE-FIT for ready-made slip covers:

- It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. *Id.*

Third-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) ("Said third party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection. Used in this limited manner, 'third party registrations are similar to dictionaries showing how language is generally used.'") (Internal citation omitted.) "Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services." *Institut National Des Appellations D'Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (third-party registrations found to be "persuasive evidence"). Here, the presence of the term "UTOPIA" in over 192 existing applications and registrations is evidence that the mark is not coined, arbitrary or distinctive. The Examiner's narrowing of the third-party registrations down to "live" applications or registrations is without any support whatsoever and appears to be pure opinion on the part of the Examiner. Similarly, the Examiner's analysis regarding the uses of the mark limited to Class 5 is without support as well. The mark "UTOPIA" was first registered in 1915 for "canned and dried fruits" and various other food products, U.S. Reg. No. 0102593. Does the fact that this registration is now expired change the fact that it was registered in 1915 on goods that arguably are in the same channels of trade of the cited registrant's goods? The Applicant believes it does not. It does show that the cited registrant did not coin the term "UTOPIA" for use on nutritional or dietary goods. Additionally, the mark "UTOPIA" is the subject of a "live" application for use on "bottled water," U.S. Reg. No. 1468587, again, arguably within the same channels of trade of the cited registrant's goods. This mark was registered in 1987, prior to the present cited registrant's application for registration. The Applicant argues that the Examiner's limitation to "live" applications and registrations and International Class 5 is improper and does not allow for a proper examination of the prior third-party marks.

Although the cited registrant's mark "UTOPIA" is contained within Applicant's mark "GREEN UTOPIA", because "Utopia" is such a highly suggestive and commonly used term, consumers are not likely to believe that the marks identify a single source for the goods simply because they both contain this term. Applicant believes that the additional wording in its mark is sufficient to distinguish the mark from the cited registrant's mark. As such, the term "UTOPIA" is a very dilute mark to such a degree that the public is inundated with this term in day to day life on an assortment of goods and services, and therefore it should be granted very narrow trademark protection on this basis. In the present case, consumers will not be confused as to the source of the goods in question due to the arbitrary nature of the Applicant's "GREEN UTOPIA" mark and the registrant's nondistinctive mark "UTOPIA". As can be seen from the above arguments, there is no likelihood of confusion.

II. CONCLUSION.

Based on the foregoing analysis, Applicant requests that the Examiner reconsider the final rejection of this application and that the present application be passed to publication at an early date. Applicant has simultaneously filed a Notice of Appeal with the Trademark Trial and Appeal Board concerning this application for registration.

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /1303-30/ Date: 01/01/2007

Signatory's Name: John S. Egbert

Signatory's Position: Attorney for Applicant

Response Signature

Signature: /1303-30/ Date: 01/01/2007

Signatory's Name: John S. Egbert

Signatory's Position: Attorney for Applicant

Serial Number: 78587872

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